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10-04-04  
Date

*Robert W. Bergstrom*  
Robert W. Bergstrom

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ted Eugene Wright  
Application No.: 09/499,069  
Filed: February 4, 2000  
Title: SINGLE-SHEET REGISTRATION FORM AND KEY PACKET

Examiner: Monica Smith Carter  
Art Unit: 3722  
Docket No.: 35008.001  
Date: October 4, 2004

Mail Stop Appeal Brief  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REQUEST FOR REINSTATEMENT OF THE APPEAL UNDER 37 CFR § 1.193(2)(ii)

Sir:

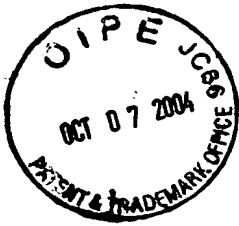
In response to the Appeal Brief filed March 5, 2004 and the subsequent Office Action dated June 4, 2004, Applicant respectfully requests the reinstatement of the appeal. Accompanying this Request is a Supplemental Appeal Brief in triplicate.

Applicant believes that no fee is required. However, at any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account No. 50-2976. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,  
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Enclosures:  
Postcard  
Transmittal in duplicate  
Supplemental Appeal Brief  
Copy of Appeal Brief



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Inventors: Ted Eugene Wright

Serial No. 09/499,069

Filed: February 4, 2000

For: SINGLE-SHEET REGISTRATION FORM AND KEY PACKET

Examiner: Monica Smith Carter

Group Art Unit: 3722

Docket No. 35008.001

Date: October 4, 2004

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SUPPLEMENTAL BRIEF ON APPEAL

Commissioner of Patents and Trademarks  
Washington, DC 20231

Sir:

In response to the re-opening of prosecution by the Examiner in the Office Communication mailed June 4, 2004, Applicant hereby requests reinstatement of the Appeal as provided under 37 CFR 1.193(b)(2).

REAL PARTY IN INTEREST

Electronic Forms Plus, Inc., is the Assignee of the present patent application. Electronic Forms Plus, Inc., is a California corporation with headquarters in San Diego, California.

RELATED APPEALS AND INTERFERENCES

Applicant's representative has not identified, and does not know of, any other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### STATUS OF CLAIMS

Claims 1-7 and 11-21 are pending in the Current Application. Claims 1-7 and 11-21 were rejected in the Office Action dated June 4, 2004. Applicant appeals the rejection of claims 1-7 and 11-21, which are copied in the attached Appendix I.

### STATUS OF AMENDMENTS

No Amendment After Final is enclosed with this brief. The last amendments to the claims were made in the Amendment filed May 23, 2003.

### SUMMARY OF INVENTION

The claimed invention is a single-sheet registration form and key packet intended for use in hotels, motels, and other such businesses in which guests or customers are registered and provided with keys. The single-sheet registration form and key packet is preprinted with general information. At the time that a guest or customer is registered, a clerk may obtain registration information from the guest, type that information into a form displayed by a computer, and print the information, or a subset of the information, onto the single-sheet registration form and key packet via a laser printer or other printing device interconnected with the computer, to produce a completed registration form and key packet. The computer uses knowledge of the format of preprinted information in order to print additional information related to a particular guest or time sensitive information onto the preprinted single-sheet registration form and key packet. The clerk, in one step, separates the registration form from the key packet along a line of perforations, and provides the registration form for the guest's signature. The clerk then quickly assembles the key packet in two steps by folding along two lines of perforations, inserts one or more room keys into slots dye-cut into the key packet, and hands the assembled key packet to the guest.

Figure 2 of the Current Application shows a single-sheet-registration-form-and-key-packet blank, prior to initial printing. The single-sheet-registration-form-and-key-packet blank includes a perforated, vertical fold line, a horizontal line of perforations 204 separating the registration form 206 from the key packet 208, a horizontal perforated fold line 210, and dye-cut slots 212 and 214 for a magnetic key card and metal key, respectively. Figure 3 of the Current Application shows the single-sheet registration form and key packet following initial printing – commonly offset printing – to produce a preprinted single-sheet-

registration-form-and-key-packet form. Preprinted single-sheet-registration-form-and-key-packet forms are loaded into a printer interconnected with a desk computer, and are printed with particular guest information and time-sensitive information, as shown in Figure 4 of the Current Application. The registration form is separated from the key packet, as shown in Figure 5 of the Current Application. The key packet is then folded along the horizontal, perforated fold line, as shown in Figure 6 of the Current Application, and then folded along the vertical, perforated fold line to produce the completed key packet, as shown in Figure 8 of the Current Application.

Example preprinted single-sheet-registration-form-and-key-packet forms were provided, in Exhibit D, in an Amendment filed on August 5, 2002, to provide definitive illustration of the claimed invention.

### ISSUES

1. Whether the Examiner has offered substantial new grounds for rejection in Office Action of June 4, 2004 that would supplement or eclipse the issues already identified in the Appeal originally filed by Applicant on March 5, 2004.

### GROUPING OF CLAIMS

Because each of the appealed independent claims 1, 11 and 16 present different facets of the present invention, and because each of the dependent claims introduce additional elements or qualifications, no grouping of the claims naturally appears that requires claims as a group to stand or fall together. Therefore, each of the appealed claims must be considered separately.

### ARGUMENT

Claims 1-21 are currently pending in the Current Application. In an Office Action dated October 6, 2003 ("Originally Appealed Office Action"), the Examiner rejected claims 1 and 7 under 35 U.S.C. § 102(b) as being anticipated by Thompson, U.S. Patent No. 3,655,119 ("Thompson"), rejected claims 2 and 5 under U.S.C. § 103(a) as being unpatentable over Thompson, and rejected claims 3, 4, and 11-21 under 35 U.S.C. § 103(a) as being unpatentable over Thompson in view of Crowell, U.S. Patent No. 4,592,573 ("Crowell").

In a most recent Office Action ("Current Office Action"), the Examiner reopened prosecution, and rejected claims 1-5 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Thompson in view of Skelton, U.S. Patent No. 4,850,611 ("Skelton"), and rejected claims 11-21 under 35 U.S.C. § 103(a) as being unpatentable over Thompson in view of Skelton and further in view of Crowell.

Applicant respectfully disagrees with these rejections.

#### Issue 1

1. Whether the Examiner has offered substantial new grounds for rejection in Office Action of June 4, 2004 that would supplement or eclipse the issues already identified in the Appeal Brief originally filed by Applicants on March 5, 2004.

Although the Examiner appears to have offered new grounds of rejection in the Current Office Action, the Examiner has, in fact, simply repeated previously offered rejections using previously cited references. For example, Thompson was first referred to by the Examiner in the initial Office Action dated October 11, 2000. Skelton and Thompson were first cited together in a 35 U.S.C. § 103(a) rejection of claim 1 in an Office Action dated July 27, 2001. Applicant's representative apparently successfully argued against that rejection, and Skelton was combined with a different set of references as the basis of a still different 35 U.S.C. § 103(a) rejection of claim 1 in an Office Action dated January 9, 2002, and in another, different 35 U.S.C. § 103(a) rejection of claim 1 in an Office Action dated August 27, 2002. Thompson reappeared in the Originally Appealed Office Action as the basis for a 35 U.S.C. § 102(b) anticipation rejection of claim 1, and then, in the Current Office Action, has again appeared together with Skelton as the basis for a 35 U.S.C. § 103(a) rejection of claim 1. Applicant's representative has been arguing for the novelty and non-obviousness of claim 1 with respect to Thompson and Skelton for over 3 years. The other claims have similar rejection histories. The Crowell reference is also not first cited in the Current Office Action, but was previously cited in the Originally Appealed Office Action. The Current Office Action adds nothing substantially new to the Examiner's position. Applicant requests that the Appeal be reinstated to avoid making additional, repetitive and unproductive arguments with respect to already well considered and repeatedly cited references.

In an Amendment filed on August 5, 2002, Applicant included a Declaration

and evidence, in Exhibits A-C, in support of a number of secondary considerations of nonobviousness. A full discussion of this Declaration and evidence was provided in the Appeal Brief submitted March 5, 2004. In the Appeal Brief, Applicant raised the issue of "[w]hether the Examiner can reject claims directed to Applicant's registration form and key packet under 35 U.S.C. § 103(a) when an extensive declaration accompanied by evidence for commercial success, copying by others, and attempts by customers to remove the "Patent Pending" notice from Applicant's claimed registration form and key packet have been twice submitted by Applicant with extensive explanation, and yet have been neither substantively responded to, nor apparently substantively considered, by the Examiner." In the Current Office Action, the Examiner states, in the "Response to Arguments" section:

Applicant argues that the examiner has failed to substantively consider or respond to the previous declaration. The examiner disagrees and asserts that the declaration was reviewed and addressed in the previous Office action mailed October 6, 2003. Furthermore, the examiner continues to maintain that the declaration is insufficient to overcome the rejections as set forth above.

There are only two statements in the Originally Appealed Office Action that Applicant believes can constitute an addressing and review of the Declaration and evidence by the Examiner:

The declaration filed August 5, 2002 along with the exhibits filed July 21, 2002 have been reviewed; however, this issue is moot in view of the newly cited rejections below. (Originally Appealed Office Action, page 3, lines 2-3)

8. Applicant's arguments with respect to claims 1-7 and 11-21 have been considered but are moot in view of the new ground(s) of rejection. (Originally Appealed Office Action, page 6, lines 10-11)

Applicant respectfully believes, as evidenced by the above quoted statement from the Current Office Action, by the above-quoted statements from the Originally Appealed Office Action, and by previous statements made by the Examiner that are quoted and discussed in detail in the Appeal Brief, that the Examiner has failed to appreciate both the legal and practical the significance of the Declaration and evidence. In Applicant's representative's opinion, the secondary considerations of nonobviousness are not moot with respect to newly offered obviousness-type rejections. Furthermore, Applicant believes that the statement "Furthermore, the examiner continues to maintain that the declaration is insufficient to overcome the rejections as set forth above" does not constitute evidence of a sufficient review and consideration of the submitted Declaration and evidence. Applicant

believes that, until the Board of Patent Appeals and Interferences reviews this issue, further prosecution is futile, and requests that the Appeal be reinstated.

Finally, because Applicant's representative did not address the Skelton reference in the Appeal Brief, Applicant's representative provides excerpts from a discussion of its inapplicability to the currently claimed invention, taken from a previously filed Amendment:

The Examiner, in the Office Action, continues to maintain that Skelton's unfolded form is rectangular and that Skelton's unfolded form could be fed through a laser printer. As Applicant's representative has argued previously, Skelton's unfolded form is clearly and unambiguously not rectangular, the dimensions are not specified, the type of paper is not specified, and many other such parameters are not provided in Skelton's disclosure. As noted in *In re Brown*, 459 F.2d 531,535, 173 USPQ 685, 688 (CCPA 1972), "[a]s a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." From Applicant's representative's experience, rectangular paper having even small departures in dimensions from standard paper sizes can cause laser printers to malfunction, let alone a relatively large protruding flap. Even were Skelton's unfolded foldable container actually rectangular, which it is not, there can be no certainty that it would be able to be fed through a laser printer without frequent jamming, or at least infrequent jamming at levels unacceptable in commercial environments. But, with a flap of relatively large area protruding from the bottom of the foldable container, it is quite probable that the foldable container could not be used in laser-printer-based applications. The Examiner argues, on page 3 of the Office Action, that the rejection is based on an embodiment of the Skelton foldable container including only 3 panels. Inspection of Figure 1 of Skelton clearly demonstrates that, as depicted, the protruding panel (43) would, in a three-panel embodiment, constitute fully 13% of the area of the three-panels, and would represent an excursion of fully 37% in the width of the rectangle formed by the three panels. To refer to the proposed 3-panel-and-protruding-flap embodiment as "rectangular" or "substantially rectangular" is simply inconsistent with the well-established meaning of those terms and is misleading. To assume that such irregular-shaped forms could be fed through a laser printer is improper, especially without disclosed dimensions of the foldable container, and in view of the relatively large, protruding flap.

The Examiner states, in the Office Action:

Applicant argues that Skelton's unfolded form is not rectangular and could not be fed through a laser printer. The examiner disagrees. As seen in the figures, panels 24,26,28,30,32,34,36,38,and 40 are individually rectangular in shape and when the envelope is complete, the shape continues to be rectangular.

Applicant's representative includes, with the response, a copy of Skelton's Figure 1 with the three-panel embodiment proposed by the Examiner outlined in red. There are 5 vertices in this proposed embodiment, marked as v1-v5 by Applicant's representative – rectangles have only four vertices. The proposed embodiment has 6 edges, marked as e1-e6 by Applicant's representative – rectangles have only four edges. *The Examiner's proposed embodiment, in its unfolded form, is not*

*rectangular*. Indeed, once folded, the folded form would be rectangular – but folded forms cannot generally be printed in computer printers. Even the thickness of single-sheet forms must be carefully controlled to allow for printing in a computer printer, as shown in materials provided as exhibits, and discussed in the following paragraph, but folded forms cannot be reliably oriented and printed in a computer printer. The single-sheet registration form and key packet includes die-cut slots and perforations for example, with critical tolerances for compatibility with a printer, and folding the single-sheet registration form and key packet prior to printing would vastly compound the problems attendant with meeting these tolerances. Whether or not the Examiner's proposed embodiment is rectangular after folding is therefore quite immaterial. (Amendment filed July 17, 2003, page 6, line 20 – page 8, line 4) (emphasis added)

Applicant provides, as an enclosure, a declaration and exhibits that detail interactions with a major client regarding certain of the many parameters that need to be considered for producing a single-sheet registration form and key packet that can be printed in a commercially available computer printer. As will hopefully be appreciated by the Examiner, producing such a form is not simply selecting dimensions and shape, although those considerations are quite important, but also involve many other considerations. Newly added claims 16-21 are directed to even more clearly claiming the single-sheet registration form and key packet in this regard. (Amendment filed July 17, 2003, page 8, line 9 – page 8, line 16)

The current claims have been extensively discussed in six Office Actions and responses. Just as the Examiner apparently has not been convinced by Applicant's representative's many arguments, Applicant is not convinced that a rather complex combination of various folders and forms disclosed in the cited references, along with modifications of those folders and forms that can only be inspired and directed by hindsight recognition of the claimed invention, can be used as a basis for an obviousness-type rejection in the face of clear, previously cited case law, and the pointed directive in MPEP § 2141, under the heading "BASIC CONSIDERATIONS WHICH APPLY TO OBVIOUSNESS REJECTIONS," that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

Applicant's arguments are currently well documented in the record. To again summarize, with respect to the rejections of claims 1-7, Skelton discloses a ticket envelope that is not rectangular in its unfolded form, does not include die-cut key slots, and that therefore, by itself, does not disclose even one of Applicant's claimed elements. (Amendment filed July 17, 2003, page 8, line 19 – page 9, line 1) (emphasis added)

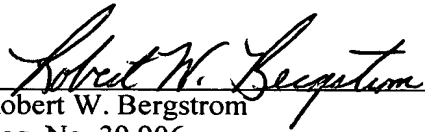
### CONCLUSION

Applicant has made a significant investment in time and money in reducing the current invention to practice, bringing the current invention to market, and building a successful business around the current invention. That business has been under threat from infringement now for several years. The Current Application was filed early in the year



2000. The Examiner has introduced no new references or substantially new arguments to justify reopening prosecution, and continued prosecution appears to Applicant to only add further delay, without possibility for resolution. Applicant requests that the Appeal be reinstated in order to expedite passage of the Current Application to issuance.

Respectfully submitted,  
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APPENDIX I

1. A rectangular, single-sheet registration form and key packet comprising:

5 a registration form;

an unfolded key packet separated from the registration form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps; and

10 one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet.

2. The single-sheet registration form and key packet of claim 1 wherein the single-sheet registration form and key packet is pre-printed with textual and graphical information.

15

3. The single-sheet registration form and key packet of claim 1 wherein the single-sheet registration form and key packet is printed on a printing device to contain textual and graphical information.

20 4. The single-sheet registration form and key packet of claim 1 wherein the single-sheet registration form and key packet is pre-printed with textual and graphical information and wherein the single-sheet registration form and key packet is printed on a printing device to contain additional textual and graphical information.

25 5. The single-sheet registration form and key packet of claim 1 wherein the single-sheet registration form and key packet is rectangular and has a greater vertical dimension than a horizontal dimension, wherein the registration form comprises the top portion of the single-sheet registration form, and wherein the registration form is separated from the unfolded key packet by a horizontal line of perforations.

30

6. The single-sheet registration form and key packet of claim 5 wherein the single-sheet registration form and key packet is bisected by a vertical line of perforations, wherein a lower tab of the unfolded key packet is separated from a central portion of the unfolded key packet by a second horizontal line of perforations, and wherein the complete key packet is formed by

folding the unfolded key packet first about the second horizontal line of perforations and then about the vertical line of perforations.

7. The single-sheet registration form and key packet of claim 1 wherein the keys are selected  
5 from a group consisting of metal keys and magnetic key cards.

11. A single-sheet registration form and key packet comprising:

a single sheet dimensioned to feed through a commercially available computer printer, the single sheet including

10 a registration form,  
an unfolded key packet separated the registration form  
by a line of perforations, the unfolded key packet including at most two lines  
of perforations that allow the unfolded key packet to be quickly and accurately  
folded into a complete key packet in two or fewer steps, and  
15 one or more die-cut slots in the unfolded key packet  
which serve as a slot or slots to hold a number of keys in the complete key  
packet.

12. The single-sheet registration form and key packet of claim 11 wherein the  
20 single sheet is a single sheet selected from one of the following materials:

paper;  
a fibrous material;  
a polymeric material;  
a cohesive film of natural fibers and filler;  
25 a cohesive film of artificial fibers and filler;  
a cohesive film of both natural and artificial fibers and filler;  
a plastic film.

13. The single-sheet registration form and key packet of claim 11 wherein the  
30 single-sheet registration form and key packet is pre-printed with textual and  
graphical information.

14. The single-sheet registration form and key packet of claim 11 wherein the

single-sheet registration form and key packet is printed on the computer printer to contain textual and graphical information.

15. The single-sheet registration form and key packet of claim 11 wherein the  
5 single-sheet registration form and key packet is pre-printed with textual and graphical information is printed on the computer printer to contain additional textual and graphical information.

16. A single-sheet registration form and key packet comprising:  
10 a single sheet having dimensions, a weight, a texture, and a moisture content that allows the single sheet to be reliably fed through a commercially available computer laser printer, the single sheet including  
a registration form,  
an unfolded key packet separated from the registration  
15 form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be accurately folded into a complete key packet in two or fewer steps, and  
one or more die-cut slots in the unfolded key packet  
which serve as a slot or slots to hold a number of keys in the complete key  
20 packet.

17. The single-sheet registration form and key packet of claim 16 wherein the single sheet is a single sheet selected from one of the following materials:  
paper;  
25 a fibrous material;  
a polymeric material;  
a cohesive film of natural fibers and filler;  
a cohesive film of artificial fibers and filler;  
a cohesive film of both natural and artificial fibers and filler;  
30 a plastic film.

18. The single-sheet registration form and key packet of claim 16 wherein the single-sheet registration form and key packet is pre-printed with textual and

graphical information.

19. The single-sheet registration form and key packet of claim 16 wherein the single-sheet registration form and key packet is printed on the computer  
5 printer to contain textual and graphical information.

20. The single-sheet registration form and key packet of claim 16 wherein the single-sheet registration form and key packet is pre-printed with textual and graphical information is printed on the computer laser printer to contain  
10 additional textual and graphical information.

21. The single-sheet registration form and key packet of claim 16 wherein the single-sheet is rectangular.